REMARKS

Claims 1-10 are pending in the present application. Reconsideration of the present application is respectfully requested in view of the arguments set forth herein.

In the Office Action, claims 1-10 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Ishii (U.S. Patent No. 6,594,505). Applicants respectfully traverse the Examiner's rejection.

An anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Levy*, 17 U.S.P.Q.2d (BNA) at 1463-64; *Skinner*, at 1789; *In re King*, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Oelrich*, at 326, quoting *Hansgirg v. Kemmer*, 40 U.S.P.Q. (BNA) 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; *see also Skinner*, at 1789.

Independent claims 1 and 5 set forth, among other things, physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols. For example, and expansion card may be physically inserted into an expansion slot of a personal data assistant. See Patent Application, page 6, ll. 20-25. In contrast, Ishii describes a mobile radio telephone 3 that may download communication protocol software from a base station 1 over a wireless communication link or air interface. See Ishii, col. 5, ll. 1-6

and Figure 1. However, the mobile radio telephone 3 is not physically attached to the base station 1. Thus, Applicants respectfully submit that Ishii fails to teach or suggest physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, as set forth in independent claims 1 and 5.

In the Final Office Action, the Examiner alleges that it is inherently possible for a telephone to be physically connected to a base station. Applicants respectfully disagree for the following reasons. First, as discussed above, inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. Applicants submit that the mobile telephones described by Ishii do not necessarily need to be physically coupled to the base stations. To the contrary, mobile telephones communicate with base stations over air interfaces and therefore are not typically physically connected to the base station. Second, contrary to the Examiner's assertion, Ishii does not describe physically coupling a mobile telephone to a base station. In particular, the portion of Ishii referenced by the Examiner (col. 2, ll. 27-51) does not describe or suggest physically connecting a mobile telephone to a base station. Ishii simply states that mobile telephones located in a communication area associated with either a first or second base station may download first or second mobile radio telephone communication protocol software from the first or second base stations depending on which base station is serving the communication area. See Ishii, col. 4, ll. 27-51. When taken in context, Applicants submit that the description in Ishii is describing downloading the mobile radio telephone communication protocol software over an air interface and not physically connecting a mobile telephone to a base station.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not anticipated by Ishii and request that the Examiner's rejections of claims 1-10 under 35 U.S.C. §102(b) be withdrawn.

Moreover, Applicants respectfully submit the present invention is not obvious in view of the prior art of record. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). As discussed above, Ishii fails to teach or suggest physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, as set forth in independent claims 1 and 5. Ishii also fails to provide any suggestion or motivation for modifying the prior art of record to arrive at Applicants claimed invention. To the contrary, Ishii teaches away from the present invention. In particular, Ishii teaches that the mobile radio telephone 3 downloads communication protocol software from a base station 1 over a wireless communication link or air interface, which teaches away from physically attaching the mobile radio telephone 3 to the base station 1. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

For at least the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned agent at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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